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40412 7590 02/27/2009 IBM CORPORATION- AUSTIN (JVL) C/O VAN LEEUWEN & VAN LEEUWEN PO BOX 90609 AUSTIN, TX 78709-0609				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* DAVID KINGSLEY CLARK, THEODORE JACK LONDON  
9 SHRADER, and JULIE LOUISE GILBREATH  
10

11  
12 Appeal 2009-0126  
13 Application 09/941,252  
14 Technology Center 3600  
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16  
17 | Decided: <sup>1</sup>February 27, 2009  
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20 *Before* ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.  
21 MOHANTY, *Administrative Patent Judges*.

22  
23 FETTING, *Administrative Patent Judge*.

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26 DECISION ON APPEAL

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28 STATEMENT OF THE CASE

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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

David Kingsley Clark, Theodore Jack London Shrader, and Julie Louise Gilbreath (Appellants) seek review under 35 U.S.C. § 134 of a non-final rejection of claims 1, 3-9, 11-17, and 19-24, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We REVERSE.

The Appellants invented an anonymous mail forwarding architecture that provides for anonymous voting (Specification Page 3, lines 1-5).

An understanding of the invention can be derived from a reading of exemplary claims 1, 3, and 6, which are reproduced below [bracketed matter and some paragraphing added].

1. A method for processing an electronic voting message, said method comprising:

[1] compiling a voter data list that includes a plurality of authorized voters;

[2] sending the voter data list to a mail forwarding service, wherein the mail forwarding service sends one or more vote requests to one or more of the plurality of authorized voters;

[3] receiving the electronic voting message from a client;

[4] determining, based on the voter data list, whether the client is authorized to vote;

[5] in response to determining that the client is authorized to vote, performing the following:

[a] removing an identity of the client from the electronic voting message, wherein the removing results in an anonymous message; and

[b] identifying one or more votes in the anonymous message; and

[6] in response to determining that the client is not authorized to vote, disregarding the electronic voting message.

- 1  
2 3. The method as described in claim 1 further comprising:  
3 sending a confirmation message to the client, the  
4 confirmation message including a summary of the  
5 determination.  
6  
7 6. The method as described in claim 1 further comprising:  
8 modifying a total number of votes, the modifying further  
9 including:  
10 adding the one or more votes to the total number of  
11 votes.  
12

13 This appeal arises from the Examiner's Non-Final Rejection, mailed  
14 January 24, 2007. The Appellants filed an Appeal Brief in support of the  
15 appeal on May 15, 2007. An Examiner's Answer to the Appeal Brief was  
16 mailed on September 5, 2007. A Reply Brief was filed on October 19, 2007.  
17

18 PRIOR ART

19 The Examiner relies upon the following prior art:

20 Bayer	US 6,311,190 B1	Oct. 30, 2001
21 Herz	US 6,460,036 B1	Oct. 1, 2002

22

23 REJECTIONS

24 Claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 stand rejected under 35 U.S.C.  
25 § 103(a) as unpatentable over Herz.

26 Claims 3, 5, 11, 13, 19, and 21 stand rejected under 35 U.S.C. §  
27 103(a) as unpatentable over Herz.

28 Claims 6, 7, 14, 15, 22, and 23 stand rejected under 35 U.S.C. §  
29 103(a) as unpatentable over Herz and Bayer.  
30

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 under 35 U.S.C. § 103(a) as unpatentable over Herz.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 3, 5, 11, 13, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Herz.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 6, 7, 14, 15, 22, and 23 under 35 U.S.C. § 103(a) as unpatentable over Herz and Bayer.

The pertinent issues turn on whether Herz describes limitation [2] of claims 1, 6, and 17.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Herz*

01. Herz is directed towards a system and method for identifying objects in an electronic media environment (column 1, lines 19-20). Herz describes the search for objects using both a frequency of terms of interest value and a user feedback value representing the user's interest in the retrieved object (column 5, lines 7-22).
02. Users are presented with target objects and users are polled to determine their interest in the target object (column 17, lines 29-50). For example, the users are presented with news clippings and

polled for their interest in the presented articles (column 18, lines 37-40). The user then submits active or passive feedback to the system regarding their interest in the object (column 18, lines 37-40).

03. Herz describes a proxy server that services a set of users (a user base). The proxy server provides a solution to privacy issues by serving as the intermediary between the information provider and the user (column 5, lines 50-53). The proxy server disassociates the identity of the user from the pseudonym by using cryptographic techniques (column 5, lines 53-55). The proxy server also permits access to target objects or user profiles (column 5, lines 55-60). The proxy server provides three functions to the user: bidirectional transfer of communications, recording of user-specific information, and as a selective forwarding agent. The function of selectively forwarding communications involves following access control functions to determine which communications to forward to the user and which to reject (column 32, lines 19-67).

04. Herz describes that the proxy server is used to protect the user from inappropriate or misrepresented target objects. This includes solicited as well as unsolicited transmissions. Furthermore, the proxy server enables parents to implement parental controls that prevent a child from accessing pornographic websites (column 48, lines 9-29).

05. Messages that are undesirable to the user or messages from an undesirable source are filtered (column 63, lines 50-54). The

1 filtered mail is either deleted or ignored (column 63, line 48). The  
2 email filtering system processes received emails to automate  
3 actions that need to be taken by the user (column 63, lines 1-19).

4 *Bayer*

- 5 06. Bayer is directed to a system and method for conducting  
6 surveys in different languages.  
7 07. Bayer is concerned with providing the users the results of the  
8 vote because the users may be the most interested in how their  
9 votes compare to others (column 1, lines 35-40).  
10 08. Bayer describes tallying the totals for each response or vote by  
11 adding the answer to records in the database (column 3, lines 7-  
12 10).

13 *Facts Related To The Level Of Skill In The Art*

- 14 09. Neither the Examiner nor the Appellants have addressed the  
15 level of ordinary skill in the pertinent arts of electronic voting.  
16 We will therefore consider the cited prior art as representative of  
17 the level of ordinary skill in the art. *See Okajima v. Bourdeau*,  
18 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific  
19 findings on the level of skill in the art does not give rise to  
20 reversible error ‘where the prior art itself reflects an appropriate  
21 level and a need for testimony is not shown’”) (quoting *Litton*  
22 *Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163  
23 (Fed. Cir. 1985)).

24 *Facts Related To Secondary Considerations*

- 25 10. There is no evidence on record of secondary considerations of  
26 non-obviousness for our consideration.

PRINCIPLES OF LAW

*Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[1] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S. Ct. at 1734. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, at 1739.

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

“For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *Id.*

“Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 1742.

#### ANALYSIS

*Claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 rejected under 35 U.S.C. § 103(a) as unpatentable over Herz*

The Appellants argue these claims as a group.

Accordingly, we select claim 1 as representative of the group.  
37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Herz describes all of the limitations of claim 1 (Answer Pages 4-5) except for limitation [6]. The Examiner took Official Notice that the practice of disregarding an unauthorized message or communication is old and well-known in the art (Answer Page 6). The Examiner then found that one of ordinary skill in the art would have known to modify Herz to include the providing for pre-authorization of users and validating the identify before forwarding their electronic voting message to include this feature disregarding an unauthorized message in order to increase security by preventing abuse of the system (Answer Page 6).

The Appellants contend that (1) Herz fails to describe limitation [1] of claims 1, 9, and 17 (Br. Page 9, first paragraph), (2) Herz fails to describe limitation [2] of claims 1, 9, and 17 (Br. Page 10, last paragraph), (3) Herz fails to describe limitation [4] of claims 1, 9, and 17 (Br. Page 11, last paragraph), (4) Herz fails to describe limitation [5] of claims 1, 9, and 17 (Br. Page 12, first paragraph), and (5) Herz fails to describe limitation [6] of claims 1, 9, and 17 (Br. Page 14, third paragraph).

1           We find that the Appellants' second argument is determinative. The  
2 Appellants contend (2) Herz fails to describe limitation [2] of claim 1 (Br.  
3 Page 10, last paragraph). We agree with the Appellants. Limitation [2]  
4 recites sending the voter list to the mail forwarding service, which in turn  
5 forwards the vote requests to the authorized voters.

6           The Examiner referred to two independent processes in Herz and  
7 found them to be part of a single process. The first process in Herz the  
8 Examiner cited to is that of making the user profiles available for sale to  
9 marketers (the voter data list) (Answer Page 12). This list of user profiles is  
10 part of the feedback process (voting process) used for searching, which is  
11 associated with the user profiles as preferences (FF 02). The second process  
12 the Examiner referred to is the email filtering system (FF 05). The email  
13 filtering system provided by Herz is for receiving emails and processing the  
14 emails such that undesirable emails are discarded (FF 05).

15           The emailing filtering system is independent of the object search  
16 system that uses the users' feedback. As such, the Examiner equated two  
17 independent processes in Herz to a single process in the claimed limitation  
18 [2]. Thus, the Examiner erred by finding that Herz describes the limitation  
19 of "sending the voter data list to a mail forwarding service, wherein the mail  
20 forwarding service sends one or more vote requests to one or more of the  
21 plurality of authorized voters." Because the Appellants' second argument is  
22 determinative, we need not reach the remaining arguments.

23           The Appellants have sustained their burden of showing that the  
24 Examiner erred in rejecting claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 under 35  
25 U.S.C. § 103(a) as unpatentable over Herz for the above reasons.

*Claims 3, 5, 11, 13, 19, and 21 rejected under 35 U.S.C. § 103(a) as unpatentable over Herz*

The Appellants argue these claims as a group.

Accordingly, we select claim 3 as representative of the group.

37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Herz described all of the limitations of claim 3 except for “sending a confirmation message to the client, the confirmation message including a summary of the determination” (Answer Page 8). The Examiner found that it was old and well-known in the art provide confirmation messages regarding a summary of a determination and that one of ordinary skill in the art would have known to modify Herz to include this feature in order to provide a user with assurance that their feedback was received (Answer Page 8).

The Appellants contend that (1) dependant claims 3, 5, 11, 13, 19, and 21 were improperly rejected for the same reasons discussed above for independent claims 1, 9, and 17 (Br. Page 15, first paragraph), (2) Herz fails to describe “sending a confirmation message to the client, the confirmation message including a summary of the determination” as per claims 3, 11, and 19 (Br. Page 15, second paragraph), and (3) Herz fails to describe “one of the votes includes a freeform comment” as per claims 5, 13, and 21 (Br. Page 15, last paragraph).

The Appellants first contend (1) dependant claims 3, 5, 11, 13, 19, and 21 were improperly rejected for the same reasons discussed above for independent claims 1, 9, and 17 (Br. Page 15, first paragraph). We agree with the Appellants. The Appellants rely on their arguments in support of claims 1, 6, and 17 above, which we found to be sufficient to overcome the

Appellants' burden and so have similarly sustained their burden of showing that the Examiner erred in rejecting claims 3, 5, 11, 13, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Herz.

*Claims 6, 7, 14, 15, 22, and 23 rejected under 35 U.S.C. § 103(a) as unpatentable over Herz and Bayer*

The Appellants argue these claims as a group.

Accordingly, we select claim 6 as representative of the group.  
37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Herz described all of the limitations of claim 6 except "modifying a total number of votes, the modifying further including: adding the one or more votes to the total number of votes" (Answer Page 10). The Examiner found that Bayer described this limitation and that one of ordinary skill in the art would have known to combine Herz and Bayer in order to increase user satisfaction (Answer Pages 10-11).

The Appellants contend that (1) dependant claims 6, 7, 14, 15, 22, and 23 were improperly rejected for the same reasons discussed above for independent claims 1, 9, and 17 (Br. Page 16, third paragraph) and (2) Bayer fails to cure the deficiencies in Herz described above (Br. Page 16, third paragraph).

The Appellants contend (1) dependant claims 6, 7, 14, 15, 22, and 23 were improperly rejected for the same reasons discussed above for independent claims 1, 9, and 17 (Br. Page 16, third paragraph). We agree with the Appellants. The Appellants rely on their arguments in support of claims 1, 6, and 17 above, which we found to be sufficient to overcome the Appellants' burden, and so have similarly sustained their burden of showing

that the Examiner erred in rejecting claims 3, 5, 11, 13, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Herz and Bayer.

#### CONCLUSIONS OF LAW

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 3-9, 11-17, and 19-24 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

#### DECISION

To summarize, our decision is as follows:

- The rejection of claims 1, 4, 8, 9, 12, 16, 17, 20, and 24 under 35 U.S.C. § 103(a) as unpatentable over Herz is not sustained.
- The rejection of claims 3, 5, 11, 13, 19, and 21 under 35 U.S.C. § 103(a) as unpatentable over Herz is not sustained.
- The rejection of claims 6, 7, 14, 15, 22, and 23 under 35 U.S.C. § 103(a) as unpatentable over Herz and Bayer is not sustained.

#### REVERSED

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